

REMARKS

Applicant thanks the Examiner for his careful review of this application. The claims have been amended to place them in better form for appeal. No new subject matter has been added. Claims 1-4, 6, 8-22 and 27-42 are currently pending in this application.

Claim Rejections 35 U.S.C. § 112

Claims 1-4, 6, 8-22 and 27-42 were rejected under 35 U.S.C. § 112, ¶1 as failing to comply with the written description requirement. Applicant respectfully traverses for at least the reasons set forth below.

The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). MPEP 2163.02.

Applicant's disclosure clearly conveys that the Applicant had possession of his inventions as claimed in claims 1-4, 6, 8-22 and 27-42. With respect to "displaying

advertisement to a user during redemption of prize credits" *see*, by way of a non-limiting example:

In addition to the foregoing capabilities, the prize redemption interface page and prize database server may include a virtual shopping cart function, a checkout capability, shipping address modification module, etc. If the virtual shopping cart function is employed, any specific prize credit that is awarded may be immediately deposited therein. At any desired time, prizes depicted on the prize redemption interface page may be added and removed. Optionally, the prize redemption interface page may display advertisements, notification of specials, legal disclaimers, etc. (Applicant's specification, page 27, lines 21-27, emphasis added)

Applicant therefore expressly disclosed in his specification the concept of "displaying advertisement to a user during redemption of prize credits." There can be no clearer indication of "possessing" a limitation of a claimed invention than expressly disclosing that limitation in his specification. The Examiner's written description rejection is therefore clearly in error.

With respect to "providing a profile of the user to an advertiser responsive to displaying advertising from the advertiser" Applicant again clearly "possessed" the invention as evidenced by the very descriptions set forth in his specification. *See*, for example:

Figure 14 illustrates an optional advertisement feedback capability of the present invention. Such feature is adapted for reporting interest in an advertisement displayed during use of a network system, and in particular, a network gaming system of the present invention. This system enables a provider of the network gaming system to focus advertising towards particular users of the network system and also report the interest shown by particular users towards particular advertisers and advertisements.

As shown in Figure 14, the advertisement feedback system of the present invention stores user profiles of a plurality of users of a network system in operation 1400. After a user logs onto the network system in operation 1402, an advertisement by a sponsor of the network system is displayed on a visual display of the particular user in operation 1404.

In response to an action by the user, the network system sends the particular user's profile to the sponsor. Note operation 1406. The user

profile may contain a great deal of previously collected information. Thus, this system allows a network system provider to strategically pass on a wealth of marketing information of the users of the network system. As an option, the method by which the marketing information is delivered may be selected by the user and may include modes of communication such as electronic mail, ground mail, etc. This selection may be effected during log-on, registration, or at any other time. Also, the user may be connected to a site on the network associated with the advertisers upon a user selecting, or "clicking" on the advertisement. If the marketing information is sent by a network provider, the advertiser may be informed of the delivery of the appropriate information.

The advertisement may relate to an offered prize or a particular game capable of being played on the network gaming system. As an option in this network gaming system embodiment, the user profile of the user may be sent to the advertiser as a result of the user being awarded a prize.

In one embodiment, the user action may occur while the advertisement is being displayed. As one option for this embodiment, the user action may comprise the user actually selecting the displayed advertisement. This way, the provider has a way to identify immediate user interest in a particular advertisement. With such an embodiment, the network system provider is able to easily relay user interest in a particular sponsor at the time that the user actually experiences the sponsor's advertisement. This embodiment also provides a way for a network system provider to determine which advertisements their users are more interested in. With this information, the provider is then able to arrange and time the display of advertisements in an manner to optimize the effectiveness of the advertisements towards the users of the network system. (Applicant's specification, page 28, line 18 to page 29, line 20, emphasis added)

Applicant therefore expressly disclosed in his specification the concept of "providing a profile of the user to an advertiser responsive to displaying advertising from the advertiser." Again, there can be no clearer indication of "possessing" a limitation of a claimed invention than expressly disclosing that limitation in his specification. The Examiner's written description rejection is therefore clearly in error for this reason as well. For at least the

forgoing reasons, Applicant respectfully requests that the rejection of claims 1-4, 6, 8-22 and 27-42 under 35 U.S.C. § 112, ¶1 be withdrawn.¹

Drawings

The Examiner objected to the drawings under 37 CFR 1.83(a). That is, the Examiner asserts that the drawings do not show every feature of the invention specified in the claims and, particular, the Examiner asserts that the limitations of “displaying advertising to a user during redemption of prize credits” and “providing a profile of the user to an advertiser responsive to displaying advertising from the advertiser” are not shown in Applicant’s drawings. Applicant respectfully traverses for at least the reasons as set forth below.

Applicant directs the Examiner’s attention to Applicant’s Fig. 14, reproduced below:

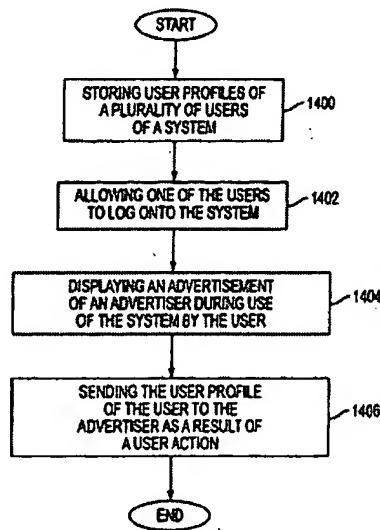


FIG. 14

¹ Applicant also respectfully points out that the present application is a continuation of 09/433,523, now U.S. Patent No. 6,758,755 which, in turn, is a continuation-in-part of USSN 09/040,654, now U.S. Patent No. 6,007,426 which, in turn, is a continuation of USSN 08/746,755, now U.S. Patent No. 5,816,918. Applicant respectfully submits that if the Examiner is going to use a parent patent to search for specification support, he should use U.S. Patent No. 6,758,755 which shares a common specification with the current application.

With respect to “displaying advertising to a user during redemption of prize credits”, operation 1404 of Fig. 14 clearly shows “displaying an advertisement of an advertiser during use of the system by the user.” Redemption of prize credits is one such use of the system by the user. The Examiner’s objection to the drawing is therefore clearly in error for at least this reason.

With respect to “providing a profile of the user to an advertiser responsive to displaying advertising from the advertiser”, operation 1406 of Fig. 14 clearly shows “sending the user profile of the user to the advertiser as a result of a user action.” As noted previously, Applicant specifically discloses that “the user action may occur while the advertisement is being displayed.” Applicant’s specification, page 29, line 12. The Examiner’s objection to the drawing is therefore clearly in error for at least this reason as well. For at least the forgoing reasons, Applicant respectfully requests that the objection to the drawings under 37 CRF 1.83(a) be withdrawn.

Conclusion

Applicant believes that the pending claims are in condition for appeal but has made some minor formatting and grammatical corrections. The Examiner is respectfully requested to enter these amendments for the purposes of appeal or allowance of the application.

Applicant believes that all pending claims are allowable and a Notice of Allowance is respectfully requested. Should the Examiner determine that a telephone conference would expedite the prosecution of this application the Examiner is invited to contact the undersigned at telephone number 650-293-3355.

Respectfully submitted,



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